

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5168-001

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature_____

Typed or printed name _____

Application Number

10/699,968

Filed

3 Nov. 2003

First Named Inventor

Bomers

Art Unit

2175

Examiner

Keaton

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 44,958
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


 Signature
 Michael D. Murphy

Typed or printed name

919-854-1844

Telephone number

14 October 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Bomers)
Serial No.: **10/699,968**)) PATENT PENDING
Filed: **November 3, 2003**)) Examiner: Sherrod Keaton
For: **Universal Computer Input Event**)) Group Art Unit: 2175
Translator)) Confirmation No.: 5026
Docket No: **5168-001**))

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
 transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date _____

This correspondence is being:

- electronically submitted via EFS-Web

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

These arguments accompany a timely Notice of Appeal and Pre-Appeal Brief Request for Review. Claims 1-4 and 6-24 are pending, including independent claims 1, 11, 12, and 14. All claims are rejected and Applicant appeals all claim rejections. The Applicant's bases for taking appeal include the below arguments, and previously submitted rebuttal arguments.

The examiner rejects claims 1, 11, 12, and 14 as obvious over U.S. Pub. 2004/0263477 A1 ("Davenport") and U.S. Pub. 2004/0257341 A1 ("Bear"). Davenport allegedly teaches all computer input event translation limitations of claims 1, 11, 12, and 14, except for implementing such translations in a personal computer (PC). Bear is not alleged as teaching any specific aspect of the claimed invention, and instead appears to be used merely as an example of a PC-

based program. On that basis, the examiner argues that it would have been obvious in a legal sense to combine Bear with Davenport, to obtain the invention of claims 1, 11, 12, and 14.

Against claims 1, 11, 12, and 14, the examiner states that one skilled in the art would have been motivated (from Bear's teachings) to implement Davenport in a PC "because it improves the efficiency of the system being that the PC provides more powerful processors." In contrast Davenport teaches that a programmed microcontroller 21 of its external input device 20 directly implements Davenport's disclosed functionality. One does not need a PC processor and no one skilled in the art would understand that a PC is needed.

However, the key legal failing of the obviousness rejection is that Davenport explicitly teaches that its inventive value derives from the implementation of event processing external to any computer or game console. Paragraph 0061 of Davenport states that "It is a significant and salient aspect of the invention that the programmed actions and sequences are stored in non-volatile memory associated with the microcontroller 21, and thus are incorporated into the invention independently of any computer or game to which the invention 20 may be connected." Paragraph 0029 states that it is significant that the microcontroller and its programming and tables (i.e., the peripheral action language) of Davenport's invention all are allocated within the external input device 20, and that "...the actions generated by the invention are independent of the computer to which it is connected."

It therefore is legal error for the examiner to state that one skilled would find it obvious from the teachings in Bear to implement Davenport as a PC program configured for execution in a PC. Davenport repeatedly teaches that its key advantages are obtained by implementing an input device 20 independent from any computer to which it is attached. Moreover, Bear is not directed to translating peripheral input events, but rather is directed to improving computer "navigation" in comparison to basic mouse/keyboard approaches. (See Abstract, Summary.) Bear is used merely for its explicit statement that Bear's invention is implemented within a PC (e.g., see paragraphs 0074, 130, and 131, as referenced by the examiner).

In further error, the examiner asserts that "Davenport has also disclosed that the peripheral action language (PAL) can be embodied outside of the input device (Figure 4b; Page 4, Paragraph 0058)." This statement apparently argues that Davenport itself suggests implementing its peripheral action processing somewhere other than the disclosed input device 20. However, paragraph 0058 and Fig. 4b of Davenport explicitly illustrate a standalone embodiment of the input device 20, which is separate from a computer—see the "TO/FROM" labeling at the rightmost side of Fig. 4b and paragraph 0045. Rather than demonstrating that Davenport could be implemented within a PC, Fig. 4b reinforces that Davenport's input event processing is independent of and external to any computer.

Turning to claims 2 and 3, their rejection rests on plain factual error. These claims stipulate that the input event translation program instructions of claim 1 include instructions to create (PC) operating system hooks to detect event messages associated with incoming input events. The claim-2 rejection argument on p. 4 vaguely states that Bear "provides the operating system," but ignores the fact that Davenport is external to a PC and includes no discussion of hooks. Moreover, the discussion of hooks in Bear (paragraphs 0007, 0116, 0117, and 0118) fails to teach or suggest the limitations of claims 2 and 3.

Claims 6 and 17 include explicit limitations to program instructions directed to "swallowing" an incoming input event. The filed application (paragraph 0022) explains that a "swallowed" event is hidden from other programs/processes running on the computer. The examiner has failed to make a *prima facie* case for the obviousness of claims 6 and 17, because neither Davenport nor Bear disclose the claimed swallowing. The examiner erroneously suggests that Davenport's event linking at paragraph 0066 is the claimed swallowing. Paragraph 0066 says nothing about swallowing an input event and instead discusses processing button clicks (one click, two clicks, one click generating two actions, etc.). It is clear factual error to argue on pp. 6 and 12 of the final action that linking actions in Davenport means that "one of the actions is swallowed."

Claim 8 includes limitations directed to determining whether an incoming input event triggers an activation of or a focus shift to a targeted program. The examiner rejects claim 8 as obvious over Davenport and Bear, but neither reference includes any discussion relevant to the claimed limitation. Bear does discuss focus (in a different context), but the examiner's rejection refers only to paragraphs 0070-0072 in Davenport for rejection support. Those paragraphs discuss 8-way scroll wheel controls and say nothing remotely relevant to the claim limitation. The multiple instances in Bear where focus is discussed (ignored by the examiner) apparently relate to navigation element activation rather than to the claim limitations.

Claim 13 includes express limitations to detecting operating system events of a PC that are associated with selected types of incoming input events, and translating those input events according to defined translation behaviors. The rejection argument on p. 9 states that Bear inherently provides a computer operating system and states that Davenport teaches everything else. The argument ignores the fact that Bear provides no teachings related to the claimed event translation and corresponding detection of PC operating system events, and the fact that Davenport is expressly taught as being implemented independent of any computer system. Davenport and Bear thus plainly fail to teach the limitations of claim 13 and the examiner has failed to make out a *prima facie* case for obviousness.

Claim 15 depends from independent claim 14 and stipulates that the computer program of claim 14 is a WINDOWS-based program. The rejection of claim 15 is based on "Official Notice" that WINDOWS programs are notoriously well known. The use of Official Notice is inapposite here. The issue is whether the computer program of claim 14 implemented as a WINDOWS program is obvious in view of Davenport and Bear. Davenport and Bear (alone or in any combination) fail to make claim 14 obvious, and claim 15 is not obvious. Moreover, in the face of Davenport's explicit teachings that its invention is independent of any computer, it is illogical to argue that it would be obvious to implement Davenport as a WINDOWS program.

Claim 20 explicitly claims that the computer program of independent claim 14 includes program instructions to time-delay input events of selected types according to a desired time delay value. The rejection argument on p. 13 of the final action states that paragraph 0066 teaches this limitation. That argument represents a clear error of fact. Paragraph 0066 in Davenport talks about how one mouse click can generate two actions (one on press, one on release), and states that a mouse user can control the time delay between press and release by simply holding down the mouse button for a desired amount of time. Davenport's description of a human user delaying mouse button releases is a legally improper basis for rejecting claim 20.

The rejection of claim 23 as indefinite and not enabled represents clear legal error. Claim 23 stipulates applying a mathematical scaling to one or more event parameters of an incoming event, and is supported in the filed application at least at paragraphs [0010], [0017], and [0020] (attenuating). As the Board of Patent Appeals & Interferences recently reiterated, "the specification need only teach those aspects of the invention that one skilled in the art could not figure out without undue experimentation." Ex Parte Mario Boschetti and Claudio Boschetti, Appeal No. 2008-1397, 2008 WL 4418250 (Bd.Pat.App. & Interf.). The scaling limitation of claim 23 is clearly enabled and no undue experimentation would be required to practice it. Further, "[a] claim is indefinite if, when read in light of the specification, it does not reasonably apprise those skilled in the art of the scope of the invention." Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1342 (Fed. Cir. 2003). The filed application discloses attenuation as one type of mathematical scaling, and those skilled in the art are reasonably apprised of claim scope.

Respectfully submitted,
COATS & BENNETT, P.L.L.C.



Michael D. Murphy
Registration No.: 44,958
Telephone: (919) 854-1844
Facsimile: (919) 854-2084

Dated: October 14, 2008